

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed March 25, 2004. Claims 1-30 were pending in the application and have been rejected. For the reasons discussed below, Applicant respectfully requests reconsideration and favorable action in this case.

Section 112 Rejections

The Examiner rejects Claims 1 and 3 under 35 U.S.C. §112. Claims 1 and 3 have been amended to address the Examiner's remarks. Favorable action is respectfully requested.

Section 102 and 103 Rejections

Claims 1-2, 8-12, 18-22, and 26-29 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,675,354 issued to Claussen et al. (hereinafter "*Claussen*"). Claims 3-7, 13-17, 23-25, and 30 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Claussen* in view of U.S. Patent No. 6,535,896, Britton et al. (hereinafter "*Britton*").

Claim 1 has been amended to include limitations similar to those in Claim 3 as originally filed (which is now cancelled). Therefore, in its discussion of Claim 1, this Response will address the Examiner's rejection of Claim 3 under Section 103. In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Claussen* nor *Britton* provide a suggestion or motivation to combine the references. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Claussen* and *Britton*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of the pending claims.

A. No Motivation or Suggestion to Combine *Claussen and Britton*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).²

In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of *Claussen* and *Britton*. For example, the Examiner merely asserts that it would have been obvious to combine the teachings of *Claussen* and *Britton* to teach the elements recited in Claim 3 (which are now in Claim 1) “because it would provide an efficient communications system that can modify and format web page content for various types of pervasive computing devices.” (Office Action, page 76). The Examiner has not provided any actual evidence of a suggestion, teaching, or motivation to make the proposed combination – the Examiner has only stated that it would be advantageous to combine the references.

Nothing in *Claussen* teaches the need to use one engine to transform standard content generation tags and a second engine to transform custom content generation tags, as recited in amended Claim 1. *Claussen* discloses a single “page handling mechanism” for processing all types of tags. Furthermore, *Britton* does not even disclose the use of standard versus custom content generation tags. Thus, the suggestion or motivation required by M.P.E.P. § 2143.01 for the proposed combination of *Claussen* and *Britton* does not exist, and the Examiner has not identified the source of such suggestion or motivation. Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-30, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

to combine the cited references. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claims 1-30.

B. The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1-30

Even assuming for the sake of argument that the cited references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Claussen* and *Britton*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, would still fail to disclose each and every element of Claims 1-30.

For example, Independent Claim 1, as amended, recites “a web page processing engine operable to receive the standard content generation tags and the custom content generation tags and to transform the standard content generation tags into first output that the web browser is able to interpret, the web page processing engine unable to interpret the custom content generation tags” and “the web page processing engine further operable to communicate the first output and the custom content generation tags to the web server.” As noted by the Examiner, *Claussen* does not disclose these limitations. The Examiner goes on to state that these limitations are disclosed in *Britton*; however, *Britton* does not disclose, teach, or suggest a web page processing engine that is able to transform standard content generation tags, but unable to interpret custom content generation tags. In fact, *Britton* does not even disclose the use of custom content generation tags. Similarly, *Britton* does not disclose communicating the first output (the transformed standard content generation tags) along with the custom content generation tags back to the web server since it does not disclose the concept of custom content generation tags. For these reasons, Applicant respectfully requests reconsideration and allowance of Claim 1, as well as the claims that depend from Claim 1. In addition, amended Claims 11, 21, and 29 contain similar, although not identical limitations as amended Claim 1. Therefore, Applicant also respectfully requests reconsideration and allowance of Claims 11, 21, and 29, as well as the claims that depend from these independent claims.

In addition to the reasons given above with respect to Claim 1, Claims 5, 15 and 24 are also allowable since neither *Claussen* nor *Britton* disclose, teach, or suggest that “the custom content generation tags comprise JSP custom tags” and that “the web page processing engine comprises a JSP engine unable to process the JSP custom tags.” First, contrary to the Examiner’s arguments, *Claussen* does not disclose JSP custom tags. Instead, *Claussen* refers to XML custom tags. In fact, *Claussen* teaches that JSP does not have custom tags. (*See Claussen*, Col. 2, ll. 35-38 and Col. 7, ll. 36-45). As described in the present Application, JSP 1.0 does not provide for custom tags, while JSP 1.1 does. (*See Application*, Page 4, line 14 – Page 5, line 11). Therefore, *Claussen*’s references to JSP not having custom tags may be referring to JSP 1.0. Furthermore, contrary to the Examiner’s arguments, *Britton* does not disclose a web page processing engine comprising a JSP engine that is unable to process the JSP custom tags. *Britton* does not even mention JSP, so it certainly does not disclose a JSP engine unable to process the JSP custom tags. Therefore, for at least this additional reason, Applicant submits that Claims 5, 15 and 24 are in condition for allowance. Favorable action is respectfully requested.

Furthermore, in addition to the reasons given above with respect to Claim 1, Claims 7 and 17 are also allowable since neither *Claussen* nor *Britton* disclose, teach, or suggest that “the web page processing engine is operable to attach a header to the custom content generation tags, the header *indicating the presence of* the custom content generation tags” and that “the web server is operable to communicate the custom content generation tags to the transformation engine *in response to* the header.” The Examiner states that *Britton* discloses these limitations (Applicant assumes that the Examiner is referring to the disclosure in *Britton* of “masking” certain portions of a web page). However, *Britton* does not disclose attaching a header to a custom content generation tag (since it doesn’t disclose such tags) and it also does not disclose that such a header indicates the presence of a custom content generation tag (since *Britton* only discloses masking portions of code, not that any specific type of code is identified). Furthermore, the masking disclosed in *Britton* certainly does not cause a web server to communicate the masked content based on the “masking”, unlike the headers recited in Claims 7 and 17. Therefore, for at least this additional reason, Applicant submits that Claims 7 and 17 are in condition for allowance. Favorable action is respectfully requested.

CONCLUSION

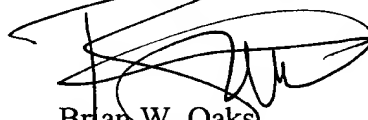
Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Brian W. Oaks, Attorney for Applicants, at the Examiner's convenience at (214) 953.6986.

No fee is believed to be due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayment to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

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